

### **REMARKS/ARGUMENTS**

The rejections presented in the Office Action dated May 16, 2006 (hereinafter Office Action) have been considered. Claims 1-27 remain pending in the application. Reconsideration of the pending claims and allowance of the application in view of the present response is respectfully requested.

With respect to the objection to Claim 22, Applicant has amended the claim to address the informality in accordance with the Examiner's suggestion. This change is believed to overcome the objection; therefore, Applicant requests that the objection be removed.

With respect to the §101 rejection of independent Claim 21 and dependent Claims 26 and 27, Applicant has amended the claims to be directed to a computer readable medium comprising program code executed in a terminal processor. Such a computer readable medium constitutes statutory subject matter in accordance with MPEP §2106. Thus, Claims 21, 26 and 27 are directed to statutory subject matter, and Applicant requests that the rejection be withdrawn.

Without acquiescing to characterizations of the asserted art, Applicant's claimed subject matter, or to the applications of the asserted art or combinations thereof to Applicant's claimed subject matter, and in an effort to facilitate prosecution, Applicant has amended each of the independent claims (Claims 1, 9 and 21) to indicate that the application of the handover algorithm is done on the basis of the checking of the state of the user interface component. Support for these changes may be found in the Specification, for example, in paragraph [0006]. The claims are believed to be patentable over the cited references for the reasons discussed below.

Each of the §103(a) rejections is based at least in part on a combination of U.S. Patent No. 6,381,468 to Larsen *et al.* (hereinafter "Larsen") in view of UK Patent Application GB 2289191 to Motorola (hereinafter "Motorola"). Each of these rejections is improper because the cited references, alone or in combination, do not correspond to the claimed invention. For example, the Examiner acknowledges that Larsen does not teach

applying a handover algorithm when a user interface is in an active state. In an attempt to overcome this absence, the Examiner relies upon the teachings of Motorola. However, Motorola also fails to at least teach applying a handover algorithm on the basis of checking the state of a user interface component. As argued in the previous Office Action Response filed on February 6, 2006, such arguments incorporated herein by reference, Motorola does not teach checking the state of a user interface component. Instead, Motorola teaches a handover management method that determines the possibility of carrying out an intra-system handover, and if such handover is not possible, an inter-system handover on the basis of previous inter-system handovers is carried out. *See, e.g.*, Figs. 2a and 2b. Thus, the handover decision taught by Motorola is not based on a check of the state of a user interface component.

As neither Larsen nor Motorola teach applying a handover algorithm on the basis of a check of the state of a user interface component, any combination of these references must also fail to teach such limitations. Since each of the above-discussed limitations is included in independent Claims 1, 9 and 21, the rejection of each of these independent claims is improper. Applicant accordingly requests that each of the §103(a) rejections be withdrawn.

Dependent Claims 2-4, 8, 10-14, 19, 23, 25 and 27 depend from independent Claims 1, 9 and 21, respectively. Each of these dependent claims also stands rejected under 35 U.S.C. §103(a) as being unpatentable over the above-discussed combination of Larsen and Motorola. While Applicant does not acquiesce to any particular rejections to these dependent claims, including any assertions concerning descriptive material, obvious design choice and/or what may be otherwise well-known in the art, these rejections are moot in view of the remarks made in connection with independent Claims 1, 9 and 21. These dependent claims include all of the limitations of their respective base claims and any intervening claims and recite additional features which further distinguish these claims from the cited references. "If an independent claim is nonobvious under 35 U.S.C. §103, then any claim depending therefrom is nonobvious." MPEP §2143.03; *citing In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988). Therefore, dependent Claims 2-4, 8, 10-14, 19, 23, 25 and 27 are also allowable over the asserted combination of Larsen and Motorola.

With particular respect to the rejection of dependent Claims 4 and 14, Applicant respectfully traverses because the asserted combination of references does not teach each of the claimed limitations. As discussed above, Motorola does not teach checking the state of the user interface component, as claimed. As the term “handover” is not found in the teachings of Larsen, Larsen would not appear to teach checking the state of the user interface component in response to a need to initiate a handover algorithm. Since neither of the cited references appears to teach the limitations of Claims 4 and 14, the asserted combination of these references cannot teach such limitations. Without a presentation of correspondence to each of the claimed limitations, the §103(a) rejection is improper and should be withdrawn.

In addition to having to show that the asserted combination of references teaches or suggests each of the claimed limitations, the Examiner must show evidence of motivation to combine these references as asserted. Applicant respectfully submits that this requirement has not been met.

The requisite evidence of motivation to combine the cited references as asserted has not been presented, nor does such motivation exist based on the cited references. The Office Action contends that a skilled artisan would have combined the teachings of Larsen and Motorola “because Larsen teaches a mobile phone in which the state/activity in the phone and the display are checked, including call activity [citation omitted] and Motorola uses a mobile phone to apply a handover algorithm when the mobile phone is actively in a calling state [citation omitted].” This is not evidence of motivation to combine the cited references but rather, is a generalized statement of what is asserted as being taught by Larsen and Motorola, respectively. No evidence, in the form of citations or otherwise, has been provided that a skilled artisan would have attempted to introduce the handover management method of Motorola to the teachings of Larsen.

The examiner must show some objective teaching leading to the asserted combination. *In re Fine*, 837 F.2d 1071, 1075, 5 USPQ2d 1596, 1600 (Fed. Cir. 1988). Since Larsen does not use the term “handover,” as discussed above, it is respectfully submitted that the teachings of Larsen and Motorola would have provided insufficient guidance for a skilled artisan

having these references before him/her to make the combination suggested by the Examiner. Applicant respectfully asserts that the Examiner's conclusion of obviousness is, instead, based on improper hindsight reasoning using knowledge gleaned only from Applicant's disclosure. As stated by the Federal Circuit:

Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability--the essence of hindsight.

*In re Dembiczak*, 50 USPQ2d 1614, (Fed. Cir. 1999) (citing *Interconnect Planning Corp. v. Feil*, 774 F.2d 1132, 1138, 227 USPQ 543, 547 (Fed. Cir. 1985)). Without a suggestion of the desirability of "the combination," a combination of such references is made in hindsight, and the "range of sources available, however, does not diminish the requirement for actual evidence." *Id.* It is a requirement that actual evidence of a suggestion, teaching or motivation to combine prior art references be shown and that this evidence be "clear and particular." *Id.* Broad conclusory statements regarding the teaching of multiple references, standing alone, are not evidence. *Id.*

As Larsen does not discuss handover, Applicant respectfully submits that the asserted combination simply does not contemplate the proposed combination. This piecemeal selection of elements is tantamount to mixing teachings out of context. Such a rejection is not permissible under §103. See *In re Kotzab*, 217 F.3d 1365 (Fed. Cir. 2000) (proposed modification must not be made in the abstract but rather made in view of the entire teaching of the prior art).

There is nothing in the references or what is in the ordinary skill in the art that would lead to combining the cited references as asserted – rather, the proffered motivation is made in hindsight. For at least the aforementioned reasons, Applicant respectfully submits that a case of *prima facie* obviousness has not been satisfied for lack of a presentation of evidence of motivation to combine the cited references. Applicant accordingly requests that the rejections be withdrawn.

With respect to the §103(a) rejections of the various dependent claims set forth in paragraphs 9-12 of the Office Action, Applicant respectfully traverses because the tertiary

references do not overcome the above discussed deficiencies of the asserted combination of Larsen and Motorola. Applicant fails to recognize where any of these references teaches applying a handover algorithm on the basis of checking the state of a user interface component. Without a presentation of evidence of correspondence to each of the claimed limitations, the §103(a) rejections are improper. Applicant accordingly requests that they be withdrawn.

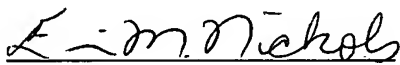
It should be noted that Applicant does not acquiesce to the Examiner's statements or conclusions concerning what would have been obvious to one of ordinary skill in the art, obvious design choices, common knowledge at the time of Applicant's invention, officially noticed facts, and the like. Applicant reserves the right to address in detail the Examiner's characterizations, conclusions, and rejections in future prosecution.

Authorization is given to charge Deposit Account No. 50-3581 (KOLS.083PA) any necessary fees for this filing. If the Examiner believes it necessary or helpful, the undersigned attorney of record invites the Examiner to contact her at the number below to discuss any issues related to this case.

Respectfully submitted,

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By: 

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